Ser. No. 09/825,207   10002844-1   13

<div align="center">REMARKS/ARGUMENTS</div>

In an Office Action mailed June 29, 2005, the Examiner rejected claims 1-37. The Examiner rejected claim 29 under section 112 as allegedly failing to comply with the written description requirement. The Examiner rejected claims 1-20, 22-24, 26-34 and 36-37 under section 103 as allegedly obvious over US 6,113,208 (Benjamin) in view of US 20020067504 (Salgado). The Examiner rejected claims 21, 25 and 35 under section 103 as allegedly obvious over Benjamin and Salgado in further view of US 6,177,860 (Cromer).

Applicants herewith amend claims 1, 3, 4, 5, 13, 16, 19, 23, 26, 29, 31 and 33. Applicants herewith cancel claims 7, 15 and 36. Applicants request that the Examiner enter new claims 38-42.

Applicants respectfully submit that the Examiner should withdraw the rejections of claims 1-37 in light of the amendments to the claims. Applicants respectfully submit that the Examiner has not established a prima facie case of unpatentability with respect to any of the pending claims, as amended. Applicants respectfully submit that none of Benjamin, Salgado or Cromer, alone or in combination, disclose, teach or suggest all of the limitations of any of the pending claims 1-6, 8-14, 15-35 or 37, as amended, or all of the limitations of new claims 38-42.

<u>Sec. 112:</u>

In the Office Action, the Examiner rejected claim 29 under 35 USC section 112, first paragraph as allegedly failing to comply with the written description requirement. The Examiner stated that the limitation, "when the printing device is installed on a host computer" is allegedly not supported by the specification as originally filed. Applicants respectfully disagree.

The claim language at issue is supported in the specification as filed at least at page 17, lines 13-14 and lines 23-24. Nevertheless, Applicants respectfully amend the claim language to recite, " . . . wherein storing the verification indicator in memory is performed when the printing device is installed ~~on a computer~~." Applicants respectfully

Ser. No. 09/825,207   10002844-1   14

submit that this claim language is fully supported in the specification as filed at least at page 17, lines 13-14 and 23-24 and at original claim 6.

<u>Sec. 103:</u>

Claims 1-6; 8-12 and 38-42:

Applicants herewith amend independent claim 1, and cancel claim 6. Applicants respectfully submit that the Examiner should therefore withdraw the rejections of claims 1-12. The amendment to claim 1 is supported in the specification as filed at least at original claim 1 and original claim 7. Amended claim 1 is similar to original claim 1 rewritten to incorporate limitations similar to those in original claim 7. The Examiner rejected original claim 7 in an office action mailed December 1, 2004.

Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness with respect to amended claim 1. In the Office Action of December 1, 2004, the Examiner stated, with respect to then-pending, original claim 7, that Benjamin allegedly "discloses the method as recited in claim 1, wherein the facilitating further comprises downloading the software update from the component memory (downloading from manufacture's website, col. 4, lines 1-20)." OA mailed 12/1/2004 at page 3. Applicant respectfully submits that that finding was in error, since "downloading from manufacture's website" does not support a finding that Benjamin discloses, teaches or suggests "wherein the facilitating further comprises downloading the software update from the component memory."

Moreover, neither Benjamin nor Salgado, alone or in combination, disclose, all of the limitations of amended claim 1 or dependent claims 2-6 and 8-12. For example, neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest at least the following limitations:

"... facilitating a download of the software update utilizing the software update information from the component memory, wherein the facilitating comprises downloading the software update from the component memory."

as recited in claim 1 and incorporated into dependent claims 2-6 and 8-12.

Ser. No. 09/825,207   10002844-1   15

Benjamin states that, a "listing may also be provided of either an internet address or a telephone number where the new printer driver can be ordered. Further, the data read from the memory cartridge can automatically cause the printer's host processor to connect to the manufacturer's Internet website where the user would have the opportunity of directly downloading an updated driver." 4:5-12. Salgado states that, a driver "will then contact a network location that is remote from the workstation on which an updated version of each printer driver may be stored 44. . . . [and] [I]f [a more current version of itself is available,] the new driver will be downloaded to the workstation 52." Paragraphs [0023]-[0024]. The references do not disclose, teach or suggest "downloading the software update from the component memory."

Claims 2-6 and 8-12 are also allowable because they depend from allowable claim 1. Each of claims 2-6 and 8-12 also include additional limitations that server to distinguish further over Benjamin and Salgado.

Claims 13, 14, 17 and 18:

Applicants herewith amend independent claim 13, cancel claim 15 and rewrite claim 16 in independent form. Applicants respectfully submit that the Examiner should therefore withdraw the rejections of claims 13, 14, 17 and 18. The amendments to claim 13 are supported in the specification as filed at least at original claim 13 and original claim 7.

Applicants respectfully submit that amended claim 13 and dependent claims 14, 17 and 18 are not obvious over Benjamin and/or Salgado. Neither Benjamin nor Salgado disclose, teach or suggest all of the limitations of independent claim 13 which is incorporated into dependent claims 2-6 and 8-12. For example, neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest at least the following limitations:

> " . . . software update information stored in the component memory, the software
> update information including information to determine if there is an update
> available for the printing device and for initiating a software update upon
> authorization from the printing device user, the software update information
> further including the update available for the printing device."

Ser. No. 09/825,207   10002844-1   16

as recited in claim 13 and incorporated into dependent claims 14, 17 and 18. Benjamin discusses a memory chip 20 with "an indication of availability of new printer driver software . . . ." 3:40-41. Salgado discusses downloading a printer driver update from "any external location accessible to the workstation or its server . . . ." Paragraph 23. Neither Benjamin nor Salgado disclose, teach or suggest that, "the software update information further including the update available for the printing device."

Claim 16:

Applicants herewith amend claim 16 and rewrite it in independent form. Amended claim 16 includes limitations similar to original claim 16 incorporating the limitations of original claim 13. The amendment is supported in the specification at least at original claims 13 and 16.

Applicants respectfully submit that amended claim 16 is not obvious over Benjamin and/or Salgado. Neither Benjamin nor Salgado disclose, teach or suggest all of the limitations of independent claim 16. For example, Neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest at least the following limitations:

> " . . . wherein the software update information for initiating a software update further comprises a pointer that may be provided to an embedded web server in the printing device so that the printing device can access the pointer and download the software update from the site."

as recited in claim 16.

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of unpatentability with respect to amended claim 16. In an Office Action mailed December 1, 2004, the Examiner stated with respect to original claim 16, that Benjamin allegedly "discloses the printing device as recited in claim 13, wherein the software update information for initiating a software update further comprises a pointer that may be provided to an embedded web server (automatically downloading updated/newer version of printer driver by printer device, col. 1, lines 1-20) in the printing device so that the printing device can access the pointer and download the software update from the

site." OA mailed 12/1/2004 at page 5. Applicants respectfully submit that this finding was in error.

Applicants respectfully submit that the cited passage does not disclose the features suggested by the Examiner. Moreover, although Benjamin discusses that "the memory cartridge can automatically cause the printer's host processor [(10)] to connect to the manufacturer's Internet website, where the user would have the opportunity of directly downloading an updated driver" (4:8-10; FIG. 2) – it does not disclose, teach or suggest "a pointer that may be provided to an embedded web server in the printing device so that the printing device can access the pointer and download the software update from the site."

Claims 19-22:

Applicants respectfully amend claim 19. The amendment is supported in the specification as filed at least at original claims 19 and 7 and at page 12, lines 17-18.

Applicants respectfully submit that claim 19 is not obvious over Benjamin and Salgado at least because neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest all of the limitations of claim 19. For example, neither Benjamin nor Salgado disclose, teach or suggest, alone or in combination, the limitation of:

> ". . . software update information stored in the memory tag that is retrieved by the laser printer and utilized to update software on the laser printer after obtaining authorization from a laser printer user, wherein the software update information includes the update available for the printing device."

as recited in amended claim 19.

Benjamin discusses that, "a message is displayed on display screen 44, indicating availability of the new printer driver. A listing is may also be provided of either an internet address or a telephone number where the new printer driver can be ordered. Further, the data read from the memory cartridge can automatically cause the printer's host processor to connect to the manufacturer's Internet website, where the user would have the opportunity of directly downloading an updated driver." 4:8-10.

Salgado states that, a driver "will then contact a network location that is remote from the workstation on which an updated version of each printer driver may be stored 44. . . . [and] [i]f [a more current version of itself is available,] the new driver will be downloaded to the workstation 52." Paragraphs [0023]-[0024].

Neither Benjamin nor Salgado disclose, teach or suggest, alone or in combination, the limitation "wherein the software update information includes the update available for the printing device" as recited in claim 19.

Dependent claims 20-22 are also allowable because they depend from allowable claim 19 and also include additional limitations which serve to further distinguish over claim 19.

Claims 23-25 and 27-30:

Applicants herewith amend claim 23 which is incorporated into dependent claims 24-25 and 27-30. The amendment is supported in the specification as filed at least at page 8, page 12, lines 17-18 and original claim 7. Applicants respectfully submit that the Examiner should therefore withdraw the rejections of claims 23-25 and 27-30.

Applicants respectfully submit that amended claim 23 is not obvious over Benjamin and/or Salgado. Neither Benjamin nor Salgado disclose, teach or suggest all of the limitations of independent claim 23. For example, Neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest at least the following limitations:

> " . . . installing a replaceable component into a printing device, wherein the replaceable component comprises a memory tag and update information stored in the memory tag and comprises a software update stored in the memory tag, wherein the software update is for at least one of software in the printing device and/or software in a host computer connected to the printing device . . . "

as recited in amended claim 23 and incorporated into dependent claims 24-25 and 27-30.

Benjamin discusses that a "a message is displayed on display screen 44, indicating availability of the new printer driver. A listing is may also be provided of either an internet address or a telephone number where the new printer driver can be ordered. Further, the data read from the memory cartridge can automatically cause the printer's host processor to connect to the manufacturer's Internet website, where the user would have the opportunity of directly downloading an updated driver." 4:3-11.

Salgado states that, a driver "will then contact a network location that is remote from the workstation on which an updated version of each printer driver may be stored 44. . . . [and] [i]f [a more current version of itself is available,] the new driver will be downloaded to the workstation 52." Paragraphs [0023]-[0024].

Neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest "a software update stored in the memory tag" as recited in amended claim 23.

Dependent claims 24-25 and 27-30 are also allowable because they depend from allowable claim 23. Each of claims 24-25 and 27-30 also include additional limitations that server to distinguish further over Benjamin and Salgado.

Claim 26:

Claim 26 is herewith amended to be similar to previous claim 26, incorporating limitations similar to those of previous claim 23. The amendment is supported in the specification as filed, at least at FIG. 4 and pages 12-19.

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with respect to claim 26. Neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest all of the limitations of claim 26. For example, neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest at least:

> " . . . determining whether the update information stored in the memory tag includes an entirety of the software update, wherein if the update information includes the entirety of the software update, downloading the software update from the memory tag . . . . "

as recited in claim 26.

Benjamin discusses that if, "the new printer driver identifier code is more recent than the identifier of the current printer driver code, the procedure moves to box 56 wherein a message is displayed on display screen 44, indicating availability of the new printer driver." 4:1-5. Benjamin does not disclose, teach or suggest "determining whether the memory tag includes an entirety of the software update" and does not disclose "wherein if the update information includes the entirety of the software update, downloading the software update from the memory tag."

Salgado discusses "reading the version information, which is stored in the initialization file . . . of the driver" and then, "contact[ing] a network location that is remote from the workstation on which an updated version of each printer driver may be stored 44." Paragraph [0023]. Salgado does not disclose, teach or suggest that "determining whether the update information stored in the memory tag includes an entirety of the software update" or "wherein if the update information includes the entirety of the software update, downloading the software update from the memory tag . . . . "

Neither Benjamin nor Salgado disclose, teach or suggest "determining whether the update information stored in the memory tag includes an entirety of the software update, wherein if the update information includes the entirety of the software update, downloading the software update from the memory tag" as recited in claim 26.

Claim 31:

Applicants herewith respectfully amend claim 31. The amendment is supported in the specification as filed at least at page 12, lines 17-18 and original claim 7. For reasons similar to those given above, with respect to claims 1, 13 and 19, neither Benjamin nor Salgado, alone or in combination, disclose, teach or suggest all of the limitations of claim 31, including, for example:

"downloading the software update from the component memory"

Applicants respectfully request that the Examiner withdraw the rejection of claim 31.

Ser. No. 09/825,207   10002844-1   21

Claim 32:

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness with respect to claim 32. In support of the rejection, the Examiner stated that claim 32 recites limitations that are similar and in the same scope of invention as to those in claim 23 above. OA at 10. Applicants respectfully submit that this finding is in error. Moreover, the Examiner failed to expressly find that either Benjamin or Salgado disclosed, taught or suggested the limitation "wherein the validating further comprises determining if a verification indicator is set in memory of the printing device" as recited in claim 32. Further, neither Benjamin nor Salgado disclose, teach or suggest all of the limitations of claim 32 including, for example, the following limitations:

> " . . . wherein the validating further comprises determining if a verification indicator is set in memory of the printing device . . . ."

as recited in claim 32. Salgado discusses that "it might be desirable or necessary to update the resident printer drivers stored <u>on a workstation</u>." It states that "each printer driver contains a program subroutine that will automatically attempt to update the resident printer driver on a workstation or print server at certain predetermined times . . . ." It states that the "driver can be programmed to simply notify the user after a download . . . ." It does not disclose, teach or suggest "determining if a verification indicator is set <u>in memory of the printing device</u> . . . ."

Claim 33-35, 37:

Applicants herewith amend claim 33 to include limitations similar to previously presented claim 33 and incorporating limitations similar to previously presented, and now cancelled, claim 36. Applicants respectfully submit that the examiner has failed to establish a prima facie case of obviousness with respect to previously presented claim 36. Moreover, the Examiner failed to expressly find that the cited references disclose, teach or suggest all of the limitations of then-pending claim 36. For example, the Examiner failed to expressly find that either Benjamin or Salgado disclosed, taught or suggested the limitation that "software instruction further include instructions to

Ser. No. 09/825,207   10002844-1   22

determine whether the software update information comprises an entirety of the software update" as recited in then-pending claim 36 and which appears in amended claim 33.

In support of the rejection of previous claim 36, the Examiner merely stated that "claims 33 through 34 and 36-37 recite limitations that are similar and in the same scope of invention as to those in claims 23-24 and 26 above." OA at page 10. Applicants respectfully submit that the Examiner's finding was in error.

Applicants respectfully submit that neither Benjamin nor Salgado, alone or in combination, disclose teach or suggest all of the limitations of claim 33, including, for example:

> "... software instructions stored in the printing device, wherein the software instructions include instructions to determine whether a verification indicator is set authorizing the software update and, if the verification indicator is set, to download the software update, and if the verification indicator is not set, to provide a user with a means to authorize the software update;
>
> wherein the software instructions further include instructions to determine whether the software update information comprises an entirety of the software update and, if the software update comprises the entirety of the software update, to download the software update from the component memory."

as recited in claim 33 and incorporated into dependent claims 34, 35 and 37.

Benjamin discusses that if, "the new printer driver identifier code is more recent than the identifier of the current printer driver code, the procedure moves to box 56 wherein a message is displayed on display screen 44, indicating availability of the new printer driver." 4:1-5.

Salgado discusses "reading the version information, which is stored in the initialization file ... of the driver" and then, "contact[ing] a network location that is remote from the workstation on which an updated version of each printer driver may be stored 44." Paragraph [0023].

Neither Benjamin nor Salgado disclose, teach or suggest "instructions to determine whether the software update information comprises an entirety of the software update" as recited in claim 33 and incorporated into dependent claims 34, 36 and 37.

New Claims 38-42:

Applicants herewith respectfully amend the claims to include new claims 38-42. Applicants respectfully submit that new claims 38-42 are allowable for reasons similar to those given above with respect to claim 1 because they depend from claim 1 and because they include additional limitations which distinguish further over the cited references. New claim 38-40 are supported in the specification as filed at least at page 8, lines 5-15. New claims 41 and 42 are supported in the specification as filed at least at page 8, lines 16-27.

Conclusion:

For the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejections of claims 1-37 and allow claims 1-6, 8-14, 16-35 and 37-42.

Respectfully submitted,

Dated: 8/4/2005
Registration No. 48,603
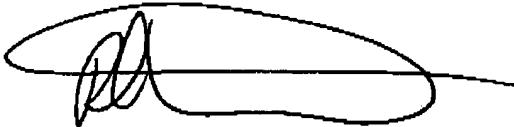
Peter Reitan

Law Offices of Larry K. Roberts, Inc.
P.O. Box 8569
Newport Beach, CA 92658-8569
Telephone (949) 640-6200
Facsimile (949) 640-1206